

Application No. 10/762,669

### **REMARKS**

With regard to the rejection of Claim 11 under 35 U.S.C. 112, which rejection is traversed since in addition to the trademark the formula is recited, Applicants have decided to cancel this claim, not because it recites the trademark, but since the subject matter thereof, that is the formula, has been included in another claim.

The rejection of the claims under 35 U.S.C. 103 as being unpatentable over U.S. Patent 5,069,991 is respectfully traversed.

The Examiner has not specifically pointed out where in this patent or why he is of the position that the polymeric solid acids of the present invention are disclosed or obvious from the teachings of the '991 patent, particularly without the benefit of the disclosure of the present application. A review of the '991 patent indicates that it requires a number of components as specifically stated in the patent, and these components are essential, see for example column 4, beginning at line 60. The electrophotographic recording element of the '991 patent, essential components, are outlined, for example, in column 3, beginning at line 50, and include an electrically conducting substrate and one or more photoconductive layers which contain one or more binders, several charge carrier producing compounds selected from certain compounds like cyan dyes, one or more charge transport compounds and additives, and wherein the charge carrier producing compounds or sensitizers are comprised of specific components as outlined in column 3, beginning at line 60, and continuing on to column 4. Also, see column 4, beginning at line 62.

A review of columns 72 and 73 referred to by the Examiner indicates that the binder b<sub>1</sub> can include cellulose ethers, polyester resins, polyvinyl chlorides, polycarbonates, copolymers of methacrylic acid, and methyl methacrylate, especially copolymers of styrene and maleic anhydride, and of styrene methacrylic acid and methacrylates provided they meet the

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above solubility conditions, reference column 73, beginning at line 7. The Examiner, however, has not established a prima facie case of obviousness with respect to the solid polymeric acid in combination with the components as recited in rejected Claim 1. Moreover, the Examiner has rendered no comments concerning the specific polymeric acids as recited in, for example, Claim 11 as filed, Claim 12, Claim 13 and other claims of the present application.

Also, the Examiner is referred to page 5 of the present application as filed, beginning at line 16, with respect to the number of advantages of the combination of components, and wherein, for example, low is about 25 to about 100 volts lower than, for example, a comparable imaging member. Further, the Examiner is referred to the lab Examples and data beginning on page 22, and note, for example, that Devices 4 and 6 that contain the polymeric acid of the present disclosure, the UCARMAG 527<sup>®</sup>, possess lower background voltages, excellent residual voltage and excellent stability discharge characteristics as compared, for example, to a member that did not contain such component. Accordingly, it is respectfully urged that the Examiner reconsider his positions and allow the claims.

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In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby requested to call Eugene O. Palazzo, at Telephone Number 585-423-4687, Rochester, New York.

Respectfully submitted,



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